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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,142	09/26/2003	David J. Yang	UTSC:664USC2	6122
32425	7590	08/24/2005	EXAMINER	
FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701			JONES, DAMERON LEVEST	
			ART UNIT	PAPER NUMBER
			1618	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,142

Applicant(s)

YANG ET AL.

Examiner

D. L. Jones

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

S.D

ACKNOWLEDGMENTS

1. The Examiner acknowledges the amendment filed 6/6/05 wherein claims 1-53 were canceled and claims 54-56, 58, 60, 61, 63, 64, 67, and 80 were amended.

Note: Claims 54-83 are pending.

2. The Examiner acknowledges the declaration filed 6/6/05 by David Yang, Chun-Wei Liu, Dong-fong Yu, and Edmund Kim. The declaration was found persuasive.

RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS

3. The Applicant's arguments filed 6/6/05 to the rejection of claims 52-83 made by the Examiner under 35 USC 102, 103, and/or double patenting have been fully considered and deemed persuasive-in-part for the reasons set forth below.

Double Patenting Rejections

I. The provisional rejection of claims 54-62, 64, and 67-83 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 32, and 38-41 of copending application number 10/732,919 is MAINTAINED for reasons of record in the office action mailed 3/8/05.

The provisional rejection of claims 54-59, 64, and 67-79 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 38-41 and 60 of copending application number 09/599,152 is MAINTAINED for reasons of record in the office action mailed 3/8/05.

II. The provisional rejection of claims 56-59 and 64-66 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 38-41 of copending application number 10/672,763 is MAINTAINED for reasons of record in the office action mailed 3/8/05.

The provisional rejection of claims 56, 57, and 64-66 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 27, 28, and 34-37 of copending application number 10/703,405 is MAINTAINED for reasons of record in the office action mailed 3/8/05.

Note: It is duly noted that Applicant intends to address the double patenting rejections at which time the claims are indicated as patentable over the prior art.

102 Rejection

The 102 rejection is WITHDRAWN because Applicant has amended the claim to overcome the rejection.

103 Rejections

The 103 rejections are WITHDRAWN because Applicant has submitted a persuasive declaration to overcome the rejections.

NEW GROUNDS OF REJECTIONS

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 54-68, 70, and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dean et al (US Patent No. 5,716,596).

Dean et al disclose radioactively labeled somatostatin-derived peptides for diagnostic (i.e., imaging) and therapeutic purposes (see entire document, especially, abstract). The pharmaceutical compositions may be used for alleviating somatostatin related diseases in animals, preferably humans (column 4, lines 34-40; column 7, lines 3-6). The peptides may be linked to a Tc-99m moiety. The bisamino bithiol Tc-99m binding moiety may have formulae I or II as set forth in columns 5-6, bridging paragraph (see also, column 8, lines 51-53). The compositions may be used as imaging agents of in vivo imaging of the mammalian body (column 6, lines 39-46). In addition, the bisamino bithiol complexes may be labeled with ^{186}Re and ^{188}Re (column 6, lines 54-59). The compositions may be used for diseases and ailments that include infection and cancer (column 7, lines 7-18; column 7, lines 35-42). The imaging agents of Dean et al may be used for visualizing organs or diagnosing disorders such as tumors (i.e., myelomas, lung carcinoma, brain tumors, tumors of the prostate, breast, colon, and ovaries) [column 9, lines 58-58].

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Dean et al and generate a method of delivering a radionuclide into target cells using a radionuclide labeled bis-aminoethane thiol (BAT) targeting ligand conjugate since both Applicant and Dean et al disclose the use of BAT targeting ligand conjugates which may be administered to humans for diagnostic and therapeutic purposes.

COMMENTS/NOTES

6. The cited prior art neither anticipates nor renders obvious the additional claims limitations of claims 69, 71-79, and 81-83 as set forth in the instant invention.


7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1618

August 22, 2005